

National Science Foundation

§ 650.13

for the administration of the invention. Whenever the NSF Patent Assistant finds that another agency also supported an NSF subject invention, he or she will consult with the grantee or contractor and appropriate personnel in the other agency to determine if a single agency should be designated to administer the Government's rights in the invention. The Patent Assistant may transfer to, or accept from, any other Federal agency, responsibility for administering a jointly-supported invention.

§ 650.11 Utilization reports.

Paragraph (h) of the standard Patent Rights clause set forth in § 650.4 obliges grantees "to submit on request periodic reports no more frequently than annually on the utilization of a subject invention or on efforts at obtaining such utilization". At this time, the Foundation does not plan to request such reports except in connection with march-in investigations conducted under § 650.13. This section will be amended to describe periodic reporting requirements if such are ever established.

[57 FR 18053, Apr. 28, 1992, as amended at 59 FR 37438, July 22, 1994]

§ 650.12 Waivers and approvals.

(a) Requests for extension of time to disclose to the NSF Patent Assistant, make an election to retain title to, or file a patent on a subject invention will be granted by the NSF Patent Assistant unless he or she determines that such an extension would either imperil the securing of valid patent protection or unacceptably restrict the publication of the results of the NSF-supported research.

(b) Approval of assignments by non-profit organizations (required by subparagraph (k)(1) of the Patent Rights clause in § 650.4(a)) will be given by the Patent Assistant unless he or she determines that the interests of the United States Government will be adversely affected by such assignment.

(c) Approval of long-term exclusive licensing of NSF-assisted inventions by nonprofit organizations (restricted by earlier versions of the NSF Patents Rights clause and by pre-Bayh-Dole Institutional Patent Agreements and

waiver conditions) will be given by the Patent Assistant unless he or she determines that the interests of the United States Government will be adversely affected by such waiver.

(d) The preference for United States industry imposed by paragraph (i) of the Patent Rights clause in § 650.4(a) may be waived by the NSF Patent Assistant as provided in that paragraph.

(e) Special restrictions on or limitation of the right of an awardee to retain title to subject inventions imposed under § 650.5 of this regulation may be waived by the Grants or Contracting Officer whenever he or she determines, after consultation with the cognizant Program Manager, that the reasons for imposing the restrictions or limitations do not require their application to a particular invention.

(f) Requests for approvals and waiver under this section should be addressed to the NSF Patent Assistant as provided in paragraph (1) of the Patent Rights clause in § 650.4(a). Requests under paragraph (a) of this section for extensions of time to disclose, elect, or file may be made by telephone or electronic mail as well as in writing. A written request for extension of time to disclose, elect, or file can be assumed to have been approved unless the Patent Assistant replies negatively within ten business days of the date such request was mailed, telecopied, or otherwise dispatched. Requests for approvals or waivers under paragraphs (b), (c), (d), and (e) of this section must be in writing and should explain why an approval or waiver is justified under the stated criteria. The requester will be given a written explanation of the reasons for denial of a request covered by this section.

§ 650.13 Exercise of march-in rights.

(a) The procedures established by this section supplement those prescribed by § 401.6 of the implementing regulation for the Bayh-Dole Act (37 CFR § 401.6) and apply to all march-in rights held by NSF including those resulting from funding agreements not covered by the Bayh-Dole Act.

(b) Petitions requesting that the NSF exercise a march-in right should be addressed to the NSF Patent Assistant. Such petitions should: